



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/685,192

10/14/2003

Duncan L. Mewherter

LOT920030025US1 (010)

4172

46321

7590

02/16/2012

CAREY, RODRIGUEZ, GREENBERG & O'KEEFE, LLP

STEVEN M. GREENBERG

950 PENINSULA CORPORATE CIRCLE

SUITE 2022

BOCA RATON, FL 33487

EXAMINER

DEBROW, JAMES J

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

02/16/2012

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/685,192
Filing Date: October 14, 2003
Appellant(s): MEWHERTER ET AL.

Steven M. Greenberg

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 November 2011 appealing from the Office action mailed 23 June 2011.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20040202349 A1	Erol et al	4-2003
20040194035 A1	Chakraborty	3-2003
7162691 B1	Chatterjee et al.	2-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 2176

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-22:

In summary, Claim 16 recites a “*machine readable storage medium*” having a “*computer program*” that performs various functions. The Specification fails to expressly limit the recited “*medium*” to a statutory embodiment. Thus, the plain and ordinary meaning of the recited “*medium*” includes signals, carrier waves, etc.

Accordingly, the recited “*machine readable storage medium*” is not a process, a machine, a manufacture or a composition of matter, and Claim 16 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

Claims 17-22 do not further define the recited “*machine readable storage medium*” as being within a statutory process, machine, manufacture or composition of matter.

Accordingly, Claims 17-22 fail to recite statutory subject matter as defined in 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 2176

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 1-5:

Claim 1 now recites “*to place a text form of the contextual data in proximity to the raster imagery of the slide show*” (see Lines 10-11). Despite reviewing the Specification of the present invention, the examiner cannot find support for the cited claim limitation. Stated differently, based upon the examiner’s review of the Specification, the examiner finds no discussion of placing a “text form” of the contextual data “in proximity to” the raster imagery of the slide show.

Therefore, Applicant is obligated to respond by explaining where in the Specification support for this limitation can be found. See *In re Alton*, 76 F.3d 1168, 1175 [37 USPQ2d 1578] (Fed. Cir. 1996). See *Hyatt v. Doll*, 91 USPQ2d 1865 (Fed. Cir., 2009).

Due at least to their dependency upon Claim 1, Claims 2-5 also recite new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 12, 14-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erol et al. (Pub. No.: 2004/0202349 A1; Filing Date: Apr. 11, 2003) (hereinafter 'Erol') in view of Chakraborty (Pub. No.: 2004/0194035 A1; Filing Date: Mar. 31, 2000) (hereinafter 'Chakraborty').

In regards to independent claim 1, Erol discloses *a system for converting slide show presentations for use within non-presentation applications, the system comprising:*

a computing system with at least one processor and memory (0041-0042);

a slide show produced by a slide show presentation application and stored in a native format (0032-0034; Erol discloses a PowerPoint presentation which may contain natural or synthetic images, photos, text or lines of text or a combination of thereof.).

a slide show conversion process executing in the memory of the computing system and configured for coupling to a non-presentation application and programmed both to extract contextual data from a slide from said slide show in its native format, to convert the slide in said slide show to raster imagery for use in said non-presentation (0032-0034; 0111; 0118; Erol discloses a PowerPoint presentation which may contain

Art Unit: 2176

natural or synthetic images, photos, text or lines of text or a combination of thereof. Erol also discloses presentation slides can be stored as a sequence of images, e.g. as JPEGs, BMPs, etc.(raster imagery). Erol further discloses using Optical Character Recognition (OCR) for extracting text from a PowerPoint file/slide.).

Erol does not expressly disclose *to place a text from of the contextual data in proximity to the raster imagery of the slide show.*

Chakraborty teaches *place a text from of the contextual data in proximity to the raster imagery of the slide show* (0021; 0024; 0037; 0055; Chakraborty teaches placing extracted text in a partial AIU file and placing extracted non-text in a partial AIU file, then combining both files to create a complete AIU file that represent all the extracted form information for the text and non-text portion of the file. Therefore the Examiner concludes it would have been obvious to one of ordinary skill in the art to modify Chakraborty teaching for the benefit of placing a text from of the contextual data in proximity to the raster imagery of the slide show.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 2, Erol does not expressly disclose *the system of claim 1, wherein said contextual data comprises a slide title for each one of said associated slides.*

However Chakraborty teaches *contextual data comprises a slide title for each one of said associated slides* (0020; 0029; 0032; 0036; Chakraborty teaches extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further teaches extracting titles and fields along with their coordinates and their styles.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 3, Erol does not expressly disclose *the system of claim 1, wherein said contextual data comprises important text associated with each one of said associated slides.*

However Chakraborty teaches *contextual data comprises important text associated with each one of said associated slides* (0020; 0022; 0024; Chakraborty teaches extracting important form information within portions that has been recognized by the system, i.e. lines as lines, text as text, etc., as well as form information that lies within images.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an

information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 4, Erol does not expressly disclose *the system of claim 1, wherein said slide show conversion process further comprises programming for generating a markup language document and for disposing said contextual data and said raster imagery within said markup language document.*

However Chakraborty teaches *generating a markup language document and for disposing said contextual data and said raster imagery within said markup language document* (0010; 0021; 0056; Chakraborty teaches the extracted information is stored as an XML (extensible markup language) file that follows a predefined DTD (document type definition. Thus Chakraborty teaches disposing said contextual data and said raster imagery within said markup language document.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 5, Erol disclose *the system of claim 1, wherein said slide show conversion process further comprises programming for reducing said raster imagery to a size suitable for display in a pervasive device* (0041; Erol discloses user interface output devices that in intended to include all possible types of devices

Art Unit: 2176

and ways to output information from data processing system. Thus Erol suggest reducing said raster imagery to a size suitable for display in a pervasive device.).

In regards to independent Claims 6 and 16, Erol discloses *a slide show presentation produced by a slide show presentation application.*

converting said first slide with said slide title into a raster image (0032-0034; 0111; 0118; Erol discloses a PowerPoint presentation which may contain natural or synthetic images, photos, text or lines of text or a combination of thereof. Erol also discloses presentation slides can be stored as a sequence of images, e.g. as JPEGs, BMPs, etc.(raster imagery).

Erol does not expressly disclose *extracting a slide title for a first slide in the slide show presentation produced by a slide presentation application executing in the memory of the computer;*

disposing both said slide title and said raster image in a markup language document;

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation;

Chakraborty teaches *extracting a slide title for a first slide in the slide show presentation produced by a slide presentation application executing in the memory of the computer* (0020; 0029; 0032; 0036; Chakraborty disclose extracting text and non-

Art Unit: 2176

text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles.).

disposing both said slide title and said raster image in a markup language document (0010; 0020; 0021; 0029; 0032; 0036; 0056; Chakraborty disclose extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles Chakraborty disclose the extracted information is stored as an XML (extensible markup language) file that follows a predefined DTD (document type definition.).

repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation (It would have been obvious to one of ordinary skill in the art that the steps of extracting, converting and disposing would be repeated for all selected group of slides within the slide show presentation.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 7 and 17, Erol does not expressly disclose *further extracting important text from said first slide.*

annotating said raster image of said first slide in said markup language document with said extracted important text.

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation.

Chakraborty teaches *further extracting important text from said first slide* (0020; 0029; 0032; 0036; Chakraborty teaches extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further disclose extracting titles and fields along with their coordinates and their styles.).

annotating said raster image of said first slide in said markup language document with said extracted important text (0010; 0037; Chakraborty disclose XML files which are referred to as Anchorable Information Unit (AIU) files. Chakraborty disclose combining a partial AIU file that contains extracted form information with another partial AIU file that contains extracted form information for non-text (images) portions of the input file. Therefore Chakraborty disclose annotating said raster image of said first slide in said markup language document with said extracted important text.).

further repeating said repeating, further extracting and annotating steps for a selected group of other slides in the slide show presentation (It would have been obvious to one of ordinary skill in the art that the steps of extracting, and annotating would be repeated for all selected group of slides within the slide show presentation.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an

Art Unit: 2176

information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 8 and 18, Erol discloses *wherein said further extracting step comprises the step of further extracting text having formatting characteristics within said first slide which emphasizes said text* (0031; 0112; 0116; Erol teaches extracting text having formatting characteristics such as color and font size.).

In regards to dependent claims 9 and 19, Erol discloses *wherein said formatting characteristics comprise a point size which exceeds a threshold value* (0091; 0112; 0116; Erol teaches the formulation for threshold selection includes a constant typically based the amount and size of the text in an image. Thus Erol teach/suggest the concept or technique of formatting characteristics comprise a point size which exceeds a threshold value.).

In regards to dependent claim 12, Erol does not expressly disclose *the method of claim 6, further comprising the step of processing said markup language document in a non-presentation application.*

Chakraborty teaches *the method of claim 6, further comprising the step of processing said markup language document in a non-presentation application* (0028; 0078).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claim 14, Erol does not expressly disclose *the method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation.*

Chakraborty teaches *the method of claim 6, further comprising the step of performing each of said extracting, disposing, converting and repeating steps in externally to a slide show presentation application which produced the slide show presentation* (0020-0025; Chakraborty disclose the steps of extracting, disposing, converting text and non-text formed information.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

In regards to dependent claims 15 and 22, Erol discloses *reducing said raster image to a size suitable for display in a pervasive device* (0041; Erol discloses user interface output devices that in intended to include all possible types of devices and

Art Unit: 2176

ways to output information from data processing system. Thus Erol suggest reducing said raster imagery to a size suitable for display in a pervasive device.).

Erol does not expressly disclose *rendering said slide title*.

Chakraborty disclose *rendering said slide title* (0020; 0029; 0032; 0036;

Chakraborty discloses extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further discloses extracting titles and fields along with their coordinates and their styles.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chakraborty with Erol for the benefit of providing an information extraction process for extracting form information associated with text portions and/or non-text portion within an electronic document (0017).

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP 2123.

Claims 10, 11, 13, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erol in view of Chakraborty, further in view of Chatterjee et al. (Patent No.: US 7,162,691 B1; Filing Date: Feb. 1, 2000) (hereinafter 'Chatterjee').

In regards to dependent claims 10 and 20, Erol in view of Chakraborty does not expressly disclose *wherein said annotating step comprises the step of generating an ALT tag with said important text in association with said raster image in said markup language document.*

However Chatterjee teaches *generating an ALT tag with said important text in association with said raster image in said markup language document* (col. 2, lines 30-37; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio or video data, or program files. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to provide a markup language document containing an ALT tag with said important text in association with said raster image.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

In regards to dependent claims 11 and 21, Erol in view of Chakraborty does not expressly disclose *wherein said generating step further comprises the step of formatting said ALT tag with additional inline indicators for facilitating an audible playback of said important text in a non-presentation application.*

However Chatterjee teaches *the step of formatting said ALT tag with additional inline indicators for facilitating an audible playback of said important text in a non-presentation application* (col. 2, lines 30-37; col. 4, lines 51-62; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio or video data, or program files.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

In regards to dependent claim 13, Erol in view of Chakraborty does not expressly disclose *the method of claim 12, wherein said processing step comprises the step of generating an agenda with each slide title for each raster image in said markup language document*. Chakraborty disclose extracting text and non-text (i.e., images) information from an electronic document. Chakraborty further discloses extracting titles and fields along with their coordinates and their styles (0020; 0029; 0032; 0036).

Chatterjee teaches *wherein said processing step comprises the step of generating an agenda with each slide title for each raster image in said markup language document* (col. 2, lines 30-37; col. 4, lines 51-62; Chatterjee teaches XML documents may contain markup tags which identify non-text data, such as image, audio

Art Unit: 2176

or video data, or program files. I t would have been obvious to one of ordinary skill in the art to modify Chakraborty's teaching with Chatterjee's teaching of markup tags for the benefit of generating an agenda with each slide title for each raster image in said markup language document.).

Therefore at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chatterjee with Erol in view of Chakraborty for the benefit of providing markup language documents containing markup tags which identify non-text data, such as image, audio or video data, or program files (col. 2, lines 30-37).).

NOTE

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

(10) Response to Argument

THE REJECTION OF CLAIM (sic) 16 THROUGH 22 UNDER 35 U.S.C. § 101

Appellant notes that the BPAI has held that a “*computer readable storage medium*” is statutory subject matter under 35 U.S.C. 101, and Appellant cites three BPAI cases (i.e., In re Mehta; In re Dureau; and In re Bash) as support. Thus, Appellant argues, the 101 rejection for Claim 16 is improper.

The examiner disagrees.

While the decisions in In re Mehta, In re Dureau, and In re Bash may be appropriate for the facts in those cases, finding that Claim 16 recites statutory subject matter in the present case would not be proper because the facts of the present case do not match the facts in In re Mehta, In re Dureau, and In re Bash.

Firstly, the decision in In re Mehta is dated November 18, 2009, which was **before** the statement by David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010). This statement provides more guidance on how to properly analyze a “medium” claim under 35 U.S.C. 101, such as Claim 16 in the present case. The examiner will discuss this statement with respect to Claim 16 of the present case in more detail below.

Secondly, the decision in In re Dureau is based on the fact that the Specification in that case **expressly distinguished** a “storage” medium from a “transmission”

Art Unit: 2176

medium (in Application Serial No. 10/271,801 --- see Specification, Page 7, Lines 17-21).

Thirdly, the decision in In re Bash is based on the facts that the claim recited a “**tangible** computer readable storage medium” and the Specification in that case **expressly distinguished** the “storage” medium from nonstatutory media (in Application Serial No. 10/976,786 --- see Specification, Page 37, Lines 6-9).

In the present case, Claim 16 recites “*A machine readable storage medium having stored thereon a computer program for [performing various functions].*”

Therefore, the question is whether Claim 16 includes signals, carrier waves, transmission media and other such nonstatutory subject matter.

The previously mentioned statement by David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) is highly relevant to the question at hand.

Importantly, this statement reads:

The broadest reasonable interpretation of a claim drawn to a computer readable medium (***also called machine readable medium and other such variations***) typically covers forms of non-transitory tangible media **and transitory propagating signals per se** in view of the ordinary and customary meaning of computer readable media,

particularly when the specification is silent. (emphasis added)

In the present case, the Specification does not once mention the recited “*machine readable storage medium*.” Additionally, the Specification does not once mention any sort of “*medium*” or “*media*.” Finally, not only does the Specification fail to once mention any sort of “*medium*” or “*media*,” it also fails to distinguish between typical “storage” media and typical “transmission” media.

Accordingly, the ordinary and customary meaning of the recited “*machine readable storage medium*” includes transitory propagating signals per se. Moreover, the facts in the present case are distinguished from the facts in In re Dureau and In re Bash.

Appellant notes that the examiner fails to realize the full import of the meaning of the term “storage.” Thus, Appellant argues, this term distinguishes the claim from “transitory” media.

The examiner disagrees.

Appellant continues to ignore the facts that the Specification in the present case fails to once mention any sort of “*medium*” or “*media*,” and to distinguish between typical “storage” media and typical “transitory” media. Arguments cannot be a substitute for what is omitted from the Specification and the Claims.

The examiner notes that, when the Specification is **silent** regarding the claimed “*storage medium*,” the BPAI has held the claim to encompass nonstatutory media. For example, see:

- Appeal No. 2009-006595 for Application Serial No. 10/626,194 → “the computer readable storage medium of this claim presumptively includes transitory signal embodiments” (see *Decision* dated 07/25/2010, Page 6).

The examiner also notes that, even when the Specification **describes** the recited “*storage medium*” and **attempts to distinguish** between typical “storage” media and typical “transmission” media, the BPAI has held the claim to encompass nonstatutory media. For example, see:

- Appeal No. 2010-011392 for Application Serial No. 11/477,194 → the BPAI held that the recited “*storage media*” “include[s] propagated signals in contravention of *Nuitjen*” (see *Decision* dated 01/10/2012, Page 5); and
- Appeal No. 2009-010581 for Application Serial No. 10/824,887 → the BPAI held that the recited “*storage medium*” includes a “propagation” medium that carries data and that “such carrying of the data amounts to temporarily storing such data in the medium until it is delivered to its destination” (see *Decision* dated 07/20/2011, Page 8).

Accordingly, the Claims 16-22 recite nonstatutory subject matter and the 101 rejection is proper.

THE REJECTION OF CLAIMS 1 AND 5 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Appellant notes that the examiner to properly articulate the “lack of written description” rejection. Appellant also argues that the rejection is improper because the recited subject matter is described in the first three lines of Page 11 of the Specification.

The examiner disagrees.

Claim 1 recites a slide show conversion process programmed to “*place a text form of the contextual data in proximity to the raster imagery of the slide show*” (see Lines 10-11) (emphasis added).

The examiner notes that that portion of the Specification cited by Appellant is actually within the first five lines of Page 11. That portion of the Specification reads:

“In block 245 the title to the slide can be passed to the non-presentation application as can the markup language document. Within the non-presentation application, in block 250 the title can be linked to the image within the markup language document and the title further can be used separately from the image such as within a meeting agenda” (emphasis added).

Here, in that portion of the Specification cited by Appellant, the disclosure describes extracting the title from a slide (that was included in a slide show) and **LINKING** it to an image in a web page. Nowhere does this cited portion of the Specification describe

Art Unit: 2176

PLACING the title of the slide (i.e., the recited “*text form of the contextual data*”) **IN**

PROXIMITY TO the image (i.e., the recited “*raster imagery of the slide show*”).

The plain and ordinary meaning the the language of Claim 16 is **PLACING** the title of the slide **NEAR** the image (i.e., “*place a text form of the contextual data in proximity to the raster imagery of the slide show*”). Conversely, the plain and ordinary meanings of the term “link” are creating a hyperlink or creating an association between two items of data (as here in the present application).

The plain and ordinary meaning of the term “link” does not include **PLACING** one item of data **NEAR** (i.e., “*in proximity to*”) another item of data. (Additionally, as an aside, when is one item of data “proximate to” another item of data? The Specification provides absolutely no guidance on that, because the Specification did not intend to describe that. Instead, the Specification intended only to describe **associating**, or linking, the title with the image.)

Accordingly, the Specification of the present application does not demonstrate to one of ordinary skill in the art that Appellant had possession of the claimed invention at the time the application was filed and the “lack of written description” rejection for Claim 1 is proper.

THE REJECTION OF CLAIMS 1-9, 12, 14 THROUGH 19 and 22 UNDER 35 U.S.C. § 103(A)

In summary, Appellant argues “Chakraborty fails to disclose the placement of anything proximate to the raster imagery of a slide show. (Brief, pages 11-13)

The Examiner disagrees.

Firstly, the examiner notes that the term “proximity” (or, any form thereof) does not appear in the disclosure of the present application. As noted above, there is also no description whatsoever of this concept in the present application. Moreover, the examiner notes that the **closeness**, or **nearness**, of one data item with respect to another data item is not described in the disclosure of the present application.

Secondly, the examiner points out that the claim recites, “*to place a text form of the contextual data in proximity to the raster imagery of the slide show*” and does **NOT** recite that the “placement” occurs within the *non-presentation application*. Accordingly, the examiner did not interpret the claim to require that the “placement” occur within the “*non-presentation application*.”

As an aside, as indicated in the above 103 rejection for that portion of the claim disclosed by Erol, the examiner interpreted the portion of the limitation that recites “*to convert the slide in said slide show to raster imagery **for use in said non-presentation***” to be intended use and not as a positively-recited limitation of the scope of the claim.

Art Unit: 2176

Chakraborty teaches extracting **text** portions and/or non-text portions (**raster images**) from an electronic file and storing the portions in separate files (0022-0024). The separate files are **combined** to create another file representing the entire input document (0037; 0055). Thus, when the separate files are combined into a single file, the system in Chakraborty “places” the text form of extracted contextual data “in proximity to” (i.e., within the same file) the extracted non-text portion (image).

Thus, Chakraborty teaches placing text in proximity to an image.

THE REJECTION OF CLAIMS 10, 11, 13, 20 AND 21 UNDER 35 U.S.C. § 103(A)

The examiner notes that Appellant's arguments correspond to the above arguments.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/JAMES J. DEBROW/

JAMES DEBROW
EXAMINER
ART UNIT 2176

Conferees:

/Doug Hutton/
Supervisory Patent Examiner, Art Unit 2176

/Laurie Ries/
Primary Examiner
Technology Center 2100
13 February 2012